



22 AUG 2006

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NEW YORK NY 10112

In re Application of :  
KOBAYASHI et al. :  
Application No.: 10/566,429 : NOTIFICATION  
Attorney Docket No.: 03500.123386 :  
For: LIQUID MEDICATION CARTRIDGE :  
AND INHALER USING THE CARTRIDGE :

This Notification is in response to applicants' "LETTER CLARIFYING INTENT TO FILE CONTINUATION UNDER 37 CFR 1.53(b)" filed via facsimile transmission on 19 May 2006.

#### **BACKGROUND**

On 29 July 2005, applicant filed international application PCT/JP2005/014361, which designated the U.S. and claimed a priority date of 02 August 2004. The thirty-month period for paying the basic national fee in the United States expires at midnight on 02 February 2007.

On 31 January 2006, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*, the basic national fee; authorization to charge any additional fees or credit any overpayment to Deposit Account No. 06-1205; a declaration of inventors; and a purported translation into English of the international application including a specification, drawings, and claims. The purported translation of the specification states that the "application is a Continuation of International Application PCT/JP2005/014361 filed July 29, 2005".

On 19 May 2006, applicants submitted the instant "LETTER CLARIFYING INTENT TO FILE CONTINUATION UNDER 37 CFR 1.53(b)" via facsimile transmission.

On 24 July 2006, a NOTICE OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.494 OR 1.495 (Form PCT/DO/EO/903) showing a 35 U.S.C. 371 date of 31 January 2006 was mailed.

#### **DISCUSSION**

Any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). The official PTO Notice published in the Official Gazette at 1077 OG 13

entitled "Minimum Requirements for Acceptance of Applications Under 35 U.S.C. 371 (the National Stage of PCT)" states, in part, the following:

The Patent and Trademark Office is continuing to receive application papers which do not clearly identify whether the papers (1) are being submitted to enter the national stage of the Patent Cooperation Treaty (PCT) under 35 U.S.C. 371 or (2) are being filed as a regular national application under 35 U.S.C. 111.

\* \* \*

If there are any conflicting instructions as to which sections of the statute (371 or 111) is intended the application will be accepted under 35 U.S.C. 111.

The transmittal letter filed on 31 January 2006 identified the application as "a filing under 35 U.S.C. 371." However, the first line of the purported translation of the specification reads "[t]his application is a Continuation of International Application PCT/JP2005/014361 filed July 29, 2005". Applicant's reference in the disclosure to benefit of the international application under 35 U.S.C. § 120 in the first sentence of the specification is inconsistent with the transmittal letter filed 31 January 2006 and contradicts the request in the transmittal letter to file under 35 U.S.C. 371. See, e.g., 35 U.S.C. 365.<sup>1</sup> The transmittal letter used by applicant is to be used only with submissions under 35 U.S.C. 371. Since applicant gave conflicting instructions, the papers should have been considered as having been filed under 35 U.S.C. 111(a). Accordingly, the original papers deposited on 31 January 2006 were improperly accepted as a submission under 35 U.S.C. 371. Therefore, the NOTICE OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.494 OR 1.495 (Form PCT/DO/EO/903) mailed 24 July 2006 is hereby VACATED. The application is deemed to have been filed under 35 U.S.C. 111(a).

#### Continuation Application

Applicant is entitled to claim benefit under 35 U.S.C. 120 and 365(c) of the filing date of the international application for the common subject matter, since this application (Serial No. 10/566,429) and the international application (PCT/JP2005/014361) designating the United States were copending on 31 January 2006.

Applicant is reminded that in order to perfect the claim for priority under 35 U.S.C. 119, applicant must submit certified copies of the priority documents. The certified copies of priority

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<sup>1</sup>Attention is also directed to MPEP 1893.03(c), which states in part:

Note: a national stage application filed under 35 U.S.C. 371 may not claim benefit of the filing date of the international application of which it is the national stage since its filing date is the date of filing of that international application. See also MPEP § 1893.03(b). Stated differently, since the international application is not an earlier application (it has the same filing date as the national stage), a priority claim in the national stage to the international application is inappropriate. Accordingly, it is not necessary for the applicant to amend the first sentence of the specification to reference the international application number that was used to identify the application during international processing of the application by the international authorities prior to commencement of the national stage under 35 U.S.C. 371.

documents submitted to the International Bureau cannot be relied upon to perfect the claim for priority. See MPEP § 1896.

**CONCLUSION**

This application is accepted as an application filed under 35 U.S.C. 111(a).

The NOTICE OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.494 OR 1.495 (Form PCT/DO/EO/903) mailed 24 July 2006 is hereby VACATED.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

This application is being forwarded to the Office of Initial Patent Examination for processing as a national application filed under 35 U.S.C. 111(a).



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